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REMARKS

This Amendment is being submitted in response to the Office Action dated 16 September 2004.

Claims 1 and 4 are amended, and claims 2 and 3 are canceled. Thus, claims 1 and 4-7 remain pending in the application.

The Examiner objected to the disclosure because it contains embedded hyperlinks:

- Page 4, line 10-reference to <http://www.quickfonns.nett>
- Page 4, line 21 -reference to <http://www.legaldocs.com>

Both references re herein canceled.

The Examiner also rejected Claims 1-3 under 35 U.S.C. 103(a) as being obvious over Heston (U.S. Publication 2002/0019741 A1) in further view of Tran (U.S. Patent 6,157,935), Accarie (U.S. Patent 6,502,144 B1), Wegner (U.S. Patent 6,032,192), Inala (U.S. Patent 6,442,590 B1), and Buchanan (U.S. Patent 5,267,155). According to the Examiner, Heston discloses all elements of claim 1 except that the legal forms are generic and stored in a database, and Heston also does not disclose expressly receiving user information from a user over an electronic communications link and packetizing the user information, rendering personalized legal document for the user by selectively merging the packetized user information into the generic legal form, and delivering the personalized legal document to the user in a secondary browser window on the user's computer screen by RTF document export. The Examiner contends that Tran discloses the use of generic forms stored on a database (See Tran, Column 37, lines 4-14). Accarie discloses receiving user information over a network, or communications link, and packetizing the user information. (See Accede, Column 10, lines 55-67, and Column 11, lines 1-5). Buchanan discloses rendering a personalized document for a user by selectively merging the user information into the generic form or template. (See Buchanan,

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Column 2, lines 54-67, Column 3, lines 1-2, and Claims 1 and 4). Inala discloses delivering a document in a secondary browser window. (See Inala, Column 10, lines 58-67, and Column 11, lines 1-3). Wegner discloses using RTF as a means of document export. (See Wegner, Column 8, lines 55-67, and Column 9, lines 1-3). The Examiner concludes that it would have been obvious to a person of ordinary skill in the art to combine these elements to arrive at the presently-claimed invention. Applicant argues that 1) the Heston reference is not prior art; 2) the cited combination still falls short of the invention as claims; and 3) this is an improper piecemeal reconstruction of the prior art.

1) Heston (U.S. Publication 2002/0019741 A1) was filed July 6, 2001. The present application derives priority from U. S. Provisional Patent Application No. 60/244,676 filed October 31, 2000. Applicant submits herewith a Declaration under 37 C.F.R. 1.132 which establishes facts to corroborate conception and reduction to practice of the present application at least as early as December 8, 1999, a full seven months earlier than the priority date of the Heston U.S. Publication 2002/0019741. Applicant contends that in light of said facts the Heston reference should not be considered to be prior art.

2) The cited combination still falls short of the amended claims. By way of background, desktop document assembly systems have been in existence since the advent of the PC. For example, Quicken Family Lawyer® has long used a database of 'skeleton' documents, a questionnaire form that allows the user to populate variables in the database, and finally a series of database commands that personalize the skeleton to create a document based on the user's inputs. A back-end word processor is included to allow formatting the database output into a finished document.

To implement this concept via the Internet was no easy matter. Instead of the skeleton residing on a database on the user PC, it resides on a server and is accessed via the Internet. Instead of a questionnaire that

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directly populates the database, an HTML page is populated on the user's computer and the information is transmitted via the Internet to the server. The database commands that personalize the skeleton are of much greater complexity when receiving inputs from an HTML page...the system must check to see if all the data that was transmitted from the user's computer has actually arrived at the server. Perhaps the most dramatic obstacle to a web version was in word processing. It becomes necessary to rely on whatever word processing capability the user's system already has. In the legal context pleadings and forms must be formatted precisely in accordance with a rule set. Prior to the present invention there were several unsatisfactory techniques employed toward this end. One sent the personalized output from the database on the server to the user via HTML pages. HTML pages do not paginate, have headers and footers on them, and cannot be read by many existing word processing programs so the resulting document was not of a quality required for producing legal documents. Another method was to have the client download a 'reader' that would take the server output and transform it into a document, but this was cumbersome and deprives the client of the use of their familiar word processor. The present system solves the problem by mining meta-tagged information from an HTML form completed by the client, allowing supervisory lawyer-selection of a skeleton document in accordance with the client's needs, inserting the meta-tagged information line-by-line into an RTF skeleton document resident on the server, and transmitting the final personalized RTF document back into a secondary browser window on the client computer, thereby allowing the client's word processor- whether it is Word, Word Perfect or Lotus Notes, to paginate the document into a finished formatted document. This makes the client experience similar to a desktop document assembly system, and yet it allows the administrator to make sure the most up to date form is available to the client (in contrast to purchasing new versions of Quicken Family Lawyer every year). All this is done under lawyer supervision without ever identifying the client to the lawyer. No other system allows a

user to enter data into an online form, supply a payment online and receive the finished documents over the Internet.

Claim 1 has been amended to reflect the implementation of this process more specifically. Claim 1 is now broken down into the following steps:

maintaining a database of generic legal forms on said web-enabled server, said maintenance of legal forms being performed under supervisory control of a lawyer remotely connected to said server for communication therewith;

presenting said client with a graphical user interface for allowing said client to select a desired type of legal document;

receiving user information from a user over an electronic communications link and packetizing said user information;

presenting said client with an HTML form for completion, said form including a plurality of questions that are selected in accordance with a legal document type selected by said client, each said question being identified within said HTML form by meta-tags;

receiving payment for a legal document using at least a portion of the user information received from the user;

receiving a corresponding plurality of answers to said selected client questions in the form of packetized data comprising individual answers and associated meta-tags;

selecting a legal form from said database of generic legal forms based on said answers to said selected questions;

rendering a personalized RTF legal document for said user by selectively merging the packetized

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individual answers with the selected legal form in said database on said web-enabled server based on said meta-tags and compiling said personalized RTF legal document;

outputting an HTML form to said user that contains a URL pointer to said personalized RTF legal document on said web-enabled server;

delivering said personalized RTF legal document to said user into a secondary browser window on said user's computer screen by RTF document export when said user clicks on said URL pointer.”

The Heston '9741 application (even though not prior art) serves to highlight the problem solved by the present invention. While it generally addresses the provision of legal documents, as explained in paragraph [0124] the legal entity leaves the client form fields blank when drafting the legal form. When the client accesses the form, the client is presented with the form and has to then input information into the data fields.

Tran discloses the use of generic forms stored on a database (See Tran, Column 37, lines 4-14). They are not RTF, and Tran shows nothing more than Quicken Family Lawyer as described above.

Accarie discloses receiving user information over a network, or communications link, and packetizing the user information. (See Accede, Column 10, lines 55-67, and Column 11, lines 1-5). This is merely packet data transmission, and does not teach or suggest “rendering a personalized RTF legal document for said user by selectively merging the packetized individual answers into said selected generic RTF legal form based on said meta-tags”, let alone any of the other elements of claim 1.

Buchanan discloses rendering a personalized document for a user by selectively merging the user information into the generic form or template. (See Buchanan, Column 2, lines 54-67, Column 3, lines 1-2, and Claims 1 and 4). There is no teaching or suggestion of how this is done in a distributed environment at all, let alone for distributed RTF document generation and delivery under third party (lawyer) supervision as specified

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in any of the foregoing italicized elements of claim 1.

Inala discloses the use of a secondary browser window (See Inala, Column 10, lines 58-67, and Column 11, lines 1-3), but it most certainly is not for delivering an RTF formatted document as required by claim 1. It is merely for opening an HTML advertisement without closing a chat room window. This fails entirely to support the Examiner's combination.

Finally, Wegner discloses using RTF as a means of document export. (See Wegner, Column 8, lines 55-67, and Column 9, lines 1-3). There is no teaching or suggestion of how to merge HTML data with RTF in a distributed environment at all, or to select and populate an RTF document under third party (lawyer) supervision, or how to send it to a remote client as specified in any of the foregoing italicized elements of claim 1.

In sum, none of the foregoing references teach or suggest all the cited elements of claim 1, even if combined. There is no teaching or suggestion of the combination of claimed steps including:

presenting said client with an HTML form for completion, said form including a plurality of questions that are selected in accordance with a legal document type selected by said client, each said question being identified within said HTML form by meta-tags;

receiving payment...;

receiving a corresponding plurality of answers to said selected client questions in the form of packetized data comprising individual answers and associated meta-tags;

selecting a legal form from said database of generic legal forms based on said answers to said selected questions;

rendering a personalized RTF legal document for said user by selectively merging the packetized

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individual answers with the selected legal form in said database on said web-enabled server based on said meta-tags and compiling said personalized RTF legal document;

outputting an HTML form to said user that contains a URL pointer to said personalized RTF legal document on said web-enabled server;

delivering said personalized RTF legal document to said user into a secondary browser window on said user's computer screen by RTF document export when said user clicks on said URL pointer.”

Specifically, none of the cited references are capable of soliciting client responses via an HTML form in a distributed environment, packetizing the answers, and using them to render a personalized RTF legal document by selectively merging the packetized individual answers with the selected legal form in said database on said web-enabled server based on said meta-tags and compiling a personalized RTF legal document. Accordingly, claim 1 is patentably distinguished. Claims 2 and 3 are herein canceled, and claims 4 and 5 depend from claim 1 and incorporate the same above-described patentable limitations.

Claim 6 specifically requires “outputting an HTML form to said user that contains a URL pointer to said RTF output file; [said user] opening a secondary browser window upon user-selection of the pointer and displaying said RTF document therein.” Similarly, claim 7 requires “delivering said personalized legal document to said user in a secondary browser window on said user’s computer screen by RTF document export.” As stated above, Inala discloses the use of a secondary browser window (See Inala, Column 10, lines 58-67, and Column 11, lines 1-3), but it most certainly is not for delivering an RTF formatted document as required by claim 1. It is merely for opening an HTML advertisement without closing a chat room window. This fails entirely to support the Examiner’s combination. Claims 6 and 7 are patentably distinguished.

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3) The cited combination is improper. Only Heston (not prior art) is concerned with any of the problems that the present invention solves, and the Examiner has resorted to a piecemeal combining of individual features of the prior art and runs afoul of the basic mandate inherent in section 103 - that piecemeal reconstruction shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). "Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious." Id. Claim 1 is patentably distinguished.

With regard to the Examiner's specific rejections of claims 4-7, Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over the foregoing and further in view of Iwai (U.S. Patent 5,119,491). Again, Heston is not prior art and the cited combination is improper. The Examiner argues that Iwai discloses analyzing a document line by line. (See Iwai, Column 6, lines 32-33). Applicant agrees but questions the relevance to line-by-line merging of HTML data with an RTF document as required by claim 4? Iwai is simply a line-by-line analysis of a document for command codes, and fails to teach or suggest claim 4 at all.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over the foregoing and further in view of Meyerzon (U.S. Patent 6,199,081). Again, Heston is not prior art and the cited combination is improper. The Examiner argues that Meyerzon uses meta-tags. This fails to teach or suggest how to use meta-tags in a line-by-line merging of HTML data with an RTF document as required by claim 5. Claim 5 is patentably distinguished.

Claim 6 was rejected under 35 U.S.C. 103(a) as being unpatentable over Heston (U.S. Publication 2002/0019741 A1) in further view of Inala (U.S. Patent 2,590 B1), Plotkin (U.S. Publication 2001/0051962

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A1), and Iwai (U.S. Patent 5,119,491). The Examiner acknowledges that Heston does not disclose expressly maintaining a database of form documents, merging the personalized information from the HTML questionnaire line by line and writing selected information in RTF format to an output file, and opening a secondary browser window upon user-selection of the pointer and displaying the RTF document therein. However, she cites Plotkin as disclosing maintaining a database of form documents (See Plotkin, Page 6, paragraph 0052), writing the information to an output file (See Plotkin, Page 5, paragraph 0043), and that the output file is in RTF format (See Plotkin, Page 3, paragraph 0031). Plotkin is simply a desktop document assembler that assembles RTF documents. There is no teaching or suggestion of how to merge HTML data with RTF in a distributed environment, or how to select and populate an RTF document under third party (lawyer) supervision, or how to send it to a remote client into a secondary browser as specified in any of the elements of claim 6. Claim 6 specifically requires *“outputting an HTML form to said user that contains a URL pointer to said RTF output file; [and] opening a secondary browser window upon user-selection of the pointer and displaying said RTF document therein.* While Inala discloses opening a secondary browser window. (See Inala, Column 10, lines 56-67, and Column 11, lines 1-3), it too is a desktop application. Neither Plotkin nor Inala are concerned with RTF document assembly in a distributed environment, and neither teaches or suggests the above-cited limitations of claim 6. Claim 6 is patentably distinguished.

Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Heston (U.S. Publication 2002/0019741 A1) Tran (6157539), Wegner (U.S. Patent 6,032,192), Inala (U.S. Patent 6,442,590 B1), Buchanan (U.S. Patent 5,267,155), and Rowe (20030171145). Claim 7 is directed to preserving the anonymity of the client from the attorney who supervises the transaction. This is recited in claim 7 as “requiring an attorney to choose a suitable legal form from said database of generic legal forms based on said collected


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information and while preserving anonymity of the user relative to the lawyer". Rowe [0135] teaches the preservation of anonymity when awarding a promotion to a user. "A promotion may be awarded to an individual anonymously without requiring identification information from the individual." This is merely sending an email award to an unnamed individual. Analogous Art is that which is "reasonably pertinent to the particular problem with which the inventor is involved." *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994). The problem encountered by the present inventor was preserving an attorney's identity whilst he/she actively participates in selecting and populating a legal document template (as required by claim 7). The design goal of Rowe was to send an anonymous award. The two goals (and mechanisms to achieve them) are wholly different, and Rowe is non-analogous prior art.

In view of the above, all pending claims 1 and 4-7 are believed to avoid all the rejections set forth in the Official Action and thus, the case should be in condition for allowance. A Notice to this effect is respectfully requested, and the Examiner is invited to call the undersigned at 410.385.2383 to discuss any remaining issues.

Respectfully submitted,

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